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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,601	10/17/2000	Malik Mamdani		2571

7590 09/09/2003

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EXAMINER

HAYES, JOHN W

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 09/09/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,601

Applicant(s)

MAMDANI ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 23, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 23, 37 and 38 are written in "single means claim" format since they recite only one element to do all the functions recited. The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. Claims 23, 37 and 38 are drawn to any "transaction fulfillment system" and "transaction apparatus" and ", regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus, claims 23, 37 and 38 yield a "transaction fulfillment system" and "transaction apparatus" that achieves a result without defining what will do so.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 10-21, 23-28 and 33-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Melick et al, U.S. Patent Application Publication No. US 2002/0195495 A1.

As per **Claims 1-2, 4, 11-12, 23 and 37**, Melick et al disclose a method and system for facilitating a wireless transaction comprising a transaction fulfillment system for:

- communicating a first transaction code to a wireless communication device from a transaction fulfillment system (Figure 5; 0024; 0025; 0027; 0028; 0040; 0045; 0053; 0064; 0065; 0072);
- optically scanning, by a transaction fulfillment system, the first transaction code from a visual display of the wireless communication device (0027; 0028; 0053; 0064; 0072).

As per **Claims 3 and 13-14**, Melick et al further disclose communicating the first transaction code from a radio transceiver of the transaction fulfillment system to a radio transceiver of the wireless communication device (0027; 0040; 0042; 0043).

As per **Claim 5**, Melick et al further disclose verifying the first transaction code in response to scanning the first transaction code (0027).

As per **Claims 6 and 10**, Melick et al further disclose communicating a decoded representation of the first transaction code from the transaction fulfillment system to a transaction management system (0027; 0028; 0053; 0072).

As per **Claims 16-18**, Melick et al further disclose communicating a message from the transaction fulfillment system to the wireless communication device after verifying the transaction code (0053; 0072).

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As per **Claim 19**, Melick et al further disclose receiving, by the transaction fulfillment system, a transaction request from the wireless communication device prior to communicating the first transaction code (0028; 0053; 0072).

As per **Claims 15 and 20**, Melick et al further disclose wherein communicating the first transaction code includes communicating a first optically scannable transaction code (0028; 0053; 0072).

As per **Claims 21 and 38**, Melick et al disclose a method and system for facilitating a wireless transaction comprising a transaction fulfillment system for:

- receiving a transaction request from a wireless communication device (0053; 0072);
- optically scanning, by a transaction fulfillment system, a transaction code from a visual display of the wireless communication device (0027; 0028; 0040; 0053; 0072); and
- enabling fulfillment of the transaction request in response to scanning the transaction code (0053; 0072).

As per **Claims 24-25**, Melick et al further disclose wherein the transaction fulfillment system is coupled to a telecommunication network system through a computer network system for enabling communication with the wireless communication device (Figure 5).

As per **Claims 26-28 and 36**, Melick et al further disclose wherein the transaction fulfillment system is coupled to a wireless data network system through a computer network system for enabling communication with the wireless communication device (Figure 5; 0027; 0040; 0066; 0067; 0068).

As per **Claims 33-34**, Melick et al further disclose a code scanning device such as a bar code reader for optically scanning the transaction code (Figure 5).

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As per **Claim 35**, Melick et al further disclose decoding the transaction code in response to optically scanning the transaction code (0027; 0028; 0053; 0072).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9, 22 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melick et al, U.S. Patent Application Publication No. US 2002/0195495 A1 in view of Pitroda, U.S. Patent No. 5,590,038.

As per **Claims 7-9**, Melick et al fail to explicitly disclose communicating a first or second fulfillment verification to the transaction management system or communicating a second transaction code to the wireless communication device. Examiner submits that communicating verification messages and multiple transaction codes in a transaction system would have been obvious to one having ordinary skill in the art at the time of applicants claimed invention. It also would have been obvious to one having ordinary skill in the art to communicate multiple transaction codes and multiple verification messages in any transaction system since it has been held that mere duplication of the essential working parts of a device or duplication of steps involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per **Claims 22 and 29-32**, Melick et al disclose a method for facilitating a wireless transaction comprising:

- receiving, by a transaction fulfillment system, a transaction request from a transaction requester (0053; 0072);

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- communicating a transaction code from the transaction fulfillment system to a wireless communication device (Figure 5; 0024; 0025; 0027; 0028; 0040; 0045; 0053; 0064; 0065; 0072);
- optically scanning, by the transaction fulfillment system, the transaction code from a visual display of the wireless communication device (0027; 0028; 0040; 0053; 0072).

Melick et al, however, fail to explicitly disclose verifying the identity of the transaction requestor through the use of a speech services module for audibly verifying the identity of the requestor by comparing voice prints. Examiner takes Official Notice that verifying the identity of a transaction requestor is notoriously well known in the business art. For example, Pitroda discloses an electronic transaction system and method for conducting electronic transactions and teaches a method for verifying the identity of a transaction requestor by displaying signatures of use of other types of identification such as photographs, finger prints or voice prints (Col. 12, lines 54-58). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Melick et al and verify the identity of the transaction requestor for obvious reasons such as ensuring that the requestor is actually the person they say they are and are authorized to carry out the transaction.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4, 11, 16-17, 20, 23-24, 27 and 30-31 of

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compending Application No. 09/690,212. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of U.S. Patent Application No. 09/690,212 recites:

- communicating a first transaction code to a wireless communication device; and
- optically scanning the first transaction code from the visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 differs since it further recites additional claim limitations including receiving a transaction request from a transaction requester, verifying an identity of the transaction requester and receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 21 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of compending Application No. 09/690,212 in view of Melick, U.S. Patent Application Publication No. US 2002/0195495 A1.

Claim 1 of U.S. Patent Application No. 09/690,212 recites:

- receiving a transaction request from a transaction requestor;

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- optically scanning a transaction code from a visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 fails to recite wherein the transaction request is received from a wireless communication device, scanning the code by a transaction fulfillment system and enabling fulfillment of the transaction request in response to scanning the transaction code. Melick et al disclose a method and system for bar code exchange and further teach the use of wireless communication devices for requesting transactions that are fulfilled through a transaction fulfillment system in response to scanning the transaction code (0024, 0025, 0027, 0040, 0053, 0064, 0072). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 1 of U.S. Patent Application No. 09/690,212 and actually enable fulfillment of the transaction request by a fulfillment system in order to actually carry out the transaction as well as provide flexibility and convenience to users who would prefer to use wireless communication devices to carry out transactions.

Claim 1 of U.S. Patent Application No. 09/690,212 also differs since it further recites additional claim limitations including receiving a transaction request from a transaction requester, verifying an identity of the transaction requester and receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

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10. Claim 22 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/690,212.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of U.S. Patent Application No. 09/690,212 recites:

- receiving a transaction request from a transaction requestor;
- verifying an identity of the transaction requestor;
- communicating a transaction code to a wireless communication device
- optically scanning a transaction code from a visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 also differs since it further recites additional claim limitations including receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

11. Claims 23-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 32-44 of copending Application No. 09/690,212. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of U.S. Patent Application No. 09/690,212 recites:

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- communicating a first transaction code to a wireless communication device; and
- optically scanning the first transaction code from the visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 differs since it further recites additional claim limitations including receiving a transaction request from a transaction requester, verifying an identity of the transaction requester and receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ramachandran [6,315,195 discloses a transaction apparatus and teach displaying a bar code on a wireless communication device used to facilitate the processing of a transaction.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

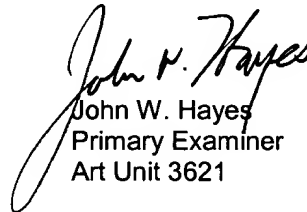
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or faxed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

September 3, 2003